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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,588	03/29/2004	Valentino Montegrando	0424-07	3207
21704	7590	08/12/2005		
LAW OFFICES OF ERIC KARICH 2807 ST. MARK DR. MANSFIELD, TX 76063				
			EXAMINER NATNITHITHADHA, NAVIN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/812,588	Applicant(s) MONTEGRANDE ET AL.	
	Examiner Navin Natnithithadha	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,8 and 9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 8, and 9, drawn to a blood pressure apparatus including an implanted sensor and a method for measuring blood pressure including providing an implanted sensor, classified in class 600, subclass 486.
 - II. Claims 3-7, drawn to an implanted sensor, classified in class 600, subclass 488.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II requires a sensor measuring pressure in general and not specifically blood pressure as required by Group I. The subcombination has separate utility such as measuring fluid pressure in a conduit other than a blood vessel, such as a urethra or esophagus.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Eric Karich on 13 June 2005 a provisional election was made without traverse to prosecute the invention of Group II, claims 3-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1, 2, 8, and 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner's Comment

2. Claim 3 uses "for" in the functional limitation of the preamble of the apparatus. Using "for" language is a recitation of the intended use of the claimed invention, which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bullara, US 4,127,110 A.

Claim 3: Bullara teaches an “implanted sensor” (implantable pressure transducer) 10 (see figs. 6 and 7) intended for measuring pressure in a body cavity (see col. 2, lines 35-38), comprising:

a “main body” (housing) 83 having an “implant inductor” (inductor) 72;

a “probe” (transducer subassembly) 68 with a “capacitor” 75 “electronically connected to the “implant inductor” (see col. 6, lines 45-47), the “probe” 68 “adapted to fit through the wall” so that the “capacitor” 75 can sense pressure in the body cavity.

The function “for measuring pressure in a conduit through a wall” is a matter of intended use of the “implanted sensor” apparatus, in which Bullara’s implantable pressure transducer 10 is capable of performing. Although Bullara teaches the implantable pressure transducer 10 measures pressure in a body cavity, such as ventricles or chambers within the brain, Bullara additionally teaches “The transducer is also suitable for implantation elsewhere in the body or in other systems, and is believed useful in any

application where a very small wireless device is needed to measure fluid or tissue pressure.” (i.e. measuring pressure in a blood vessel).

Claim 4: Bullara teaches the “probe” 68 includes a “neck portion” (not labeled) that extends outwardly to a “head portion” (not labeled) (see fig. 7).

Claim 5: Bullara teaches the “head portion” includes a “terminus” (not labeled) that forms an “aperture” (not labeled) that is covered with a “flexible membrane” 95 that defines an “internal chamber” (not labeled, space between bellows 77 and membrane 95) (see figs. 6 and 7).

Claim 6: Bullara teaches the “capacitor” 75 is operatively positioned adjacent the “internal chamber” (see fig. 6).

Claim 7: Bullara teaches the “internal chamber” is filled with “biocompatible fluid” (distilled water, a fluid compatible with the characteristics of the fluid being monitored, or Elliot’s ‘B’ solution) (see col. 6, lines 25-29, and col. 7, lines 29-35).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Navin Natnithithadha
Patent Examiner
GAU 3736
12 August 2005